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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/669,365

09/25/2003

R. Douglas Cassel

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03/06/2008

JONES DAY

222 East 41st Street

New York, NY 10017-6702

EXAMINER

VU, JAKE MINH

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/669,365	Applicant(s) CASSEL, R. DOUGLAS	
	Examiner JAKE M. VU	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 15, 18, 19 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-14, 16, 17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Applicant's Restriction Requirement Response filed on 12/27/2007; Request for Continued Examination and Amendment filed on 04/20/2007.

- Claim 1 has been amended.
- Claims 1-25 are pending in the instant application.
- Claims 7-9, 15, 18 and 19 are drawn to non-elected species.
- Claims 7-9, 15, 18, 19 and 25 are withdrawn from consideration.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/20/2007 has been entered.

Election/Restrictions

Applicant's election of Group I (claims 1-24) and elected species "laparoscopy", "lidocaine", and "monolithic drug-in-adhesive" in the reply filed on 12/27/2007 is acknowledged. Because applicant did not distinctly and specifically point out the

supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

Claims 1-4 and 10 rejected under 35 U.S.C. 102(b) as being anticipated by KELLY (*An assessment of the value of intraperitoneal bupivacaine for analgesia after laparoscopic sterilization*. Br J Obstet Gynaecol. 1996 Aug;103(8):837-9) **are withdrawn** in view of Applicant's amendment and the prior art disclosing the fallopian tube was Filshie clipped.

However, upon further consideration, a new ground(s) of rejection is made as discussed below.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by PELLAND (*The application of lidocaine to the fallopian tubes during tubal fulguration by laparoscopy*. Obstet Gynecol. 1976 Apr;47(4):501-2).

Applicant's claims are directed to a method of ameliorating pain from a surgically closed wound in a patient comprising applying a topical local anesthetic, such as

lidocaine, on an exterior surface of the surgically closed wound, in which the surgical procedure is by laparoscopy.

PELLAND disclosed a method of reducing discomfort from a surgically closed wound in a patient comprising applying a topical local anesthetic, such as lidocaine, on an exterior surface of the surgically closed wound, such as the fallopian tube after tubal fulguration closure, in which the surgical procedure is by laparoscopy (see abstract).

Claim Rejections - 35 USC § 103

Claims 1-6, 10-14, 16, 17 and 20-24 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ZHANG (US 6,528,086) **are maintained** for reasons of record in the previous office action filed on 03/28/2006.

Response to Arguments

Applicant argues that ZHANG teach or suggest a method for ameliorating the pain of a surgically closed wound, in which ZHANG is more addressing anesthesia required before and during specified medical procedures, such as would be required for debridement of burned tissues and cleansing or closing ulcers. The Examiner finds this argument unpersuasive, because ZHANG disclosed post-surgical wounds, in which the term "post" refers to after the surgery (see col. 17, line 23-37).

Applicant argues that ZHANG does not teach or suggest the use of a patch as recited in Applicant's independent claim 25. The Examiner finds this argument moot,

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because claim 25 has been withdrawn from consideration. Nonetheless, ZHANG teaches using a patch at column 17, line 37).

Telephonic Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKE M. VU whose telephone number is (571)272-8148. The examiner can normally be reached on Mon-Tue and Thu-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jake M. Vu/

Jake M. Vu, PharmD, JD
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